

## REMARKS/ARGUMENTS

### *Status of the Application*

Claims 1-25 and 48-62 were pending in this case during examination leading to the outstanding Office Action. Claims 24, 25, and 55 stand rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In addition, claims 1, 4-7, 11, 15, 17-19, 21, 24, 25, and 55 stand rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Wells (United States Patent No. 5,185,269) in view of Elliot et al. (United States Patent No. 5,935,859) and claims 2, 12-14, 17, and 18 stand rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Wells in view of Elliot et al. above as applied to claim 1, in further view of Sakai et al. (United States Patent No. 4,937,048). Furthermore, claims 3, 8-10, 16, 20, 22, 23, 48-54, and 56-62 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

In this Response, claims 3, 7, 15, 19, 21 and 55 have been canceled and claims 1, 8, 10, 11, 16, 17, 20, 22, 24, 48, 51, 52, 54, 56, 57 and 60 have been amended. Upon entry of the Response, claims 1, 2, 4-6, 8-14, 16-18, 19, 20, 22-25, 48-54 and 56-62 will be pending in the case.

### *35 U.S.C. § 112, Second Paragraph, Rejections*

Claim 24 is rejected because the limitation "said substrate" was not considered by the examiner to be an element of the invention because it allegedly is not positively recited as an element of the system. Applicant respectfully traverses this rejection and reasoning stated in the Office Action because the limitation "a substrate" is recited in claim 21, from which claim 24 depends. However, in order to move prosecution of this application along, Applicant has amended claim 24 to more clearly recite "a substrate" in claim 24. Accordingly, withdrawal of the rejection of claim 24 under 35 U.S.C. § 112, second paragraph, is requested.

Claims 25 and 55 are rejected because the examiner alleges that it is unclear what is meant by the limitation "field of view." Applicant respectfully traverse this rejection because Applicant submits that the term itself is clear and, in addition, the specification provides an adequate description of this term such that one of ordinary skill in the art would understand the scope and meaning of the claim. Referring to Figures 8A-8C, for example, various embodiments of the bead detection system and the field of view are described. *See* Specification pages 27-31. Additional embodiments of the detection system are shown and described with reference to Figures 14 and 15. *See* Specification pages 38-41. In addition, the term field of view is used at page 5, line 20; page 6, line 14; page 8, line 1; page 30, lines 11 and 18. Claim 55 has been cancelled, but the limitations of claim 55 have been incorporated into rewritten claim 56. Accordingly, withdrawal of the rejection of claims 25 and 55 under 35 U.S.C. § 112, second paragraph, is requested.

#### ***35 U.S.C. § 103(a) Rejections***

In the Office Action, claims 1, 4-7, 11, 15, 17-19, 21, 24, 25, and 55 stand rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Wells (United States Patent No. 5,185,269) in view of Elliot et al. (United States Patent No. 5,935,859) and claims 2, 12-14, 17, and 18 stand rejected under 35 U.S.C. § 103 (a) as allegedly being unpatentable over Wells in view of Elliot et al. above as applied to claim 1, further in view of Sakai et al. (United States Patent No. 4,937,048).

#### **Prima Facie Obviousness**

Applicant traverses the obviousness rejections because the examiner has failed to establish a *prima facie* case of obviousness. The examiner has summarized the prior art references relied upon in forming the rejection, but has not applied the references to the claims. The Office Action does not express or imply how the cited references suggest all of the claim limitations. The examiner has not presented any line of reasoning comparing the claim limitations to the cited references or explained why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references. *See* MPEP 2142 and 2143.

In any event, in an effort to move prosecution along,

1. Applicant has rewritten claim 1 to include the limitations of claim 3, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 3 has been canceled. Claims 2, 4-6 and 12-14 depend, either directly or indirectly, from claim 1. Accordingly, it is requested that the rejection of claims 1, 2-6, and 12-14 under 35 U.S.C. § 103 (a) be withdrawn.

2. Applicant has rewritten claim 8 to include the limitations of claims 1 and 7, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 7 has been canceled. Claims 9-11 depend from claim 8. Accordingly, it is requested that the rejection of claims 7-11 under 35 U.S.C. § 103 (a) be withdrawn.

3. Applicant has rewritten claim 16 to include the limitations of claims 1 and 15, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 15 has been canceled. Claims 17 and 18 depend from claim 16. Accordingly, it is requested that the rejections of claims 15-18 under 35 U.S.C. § 103 (a) be withdrawn.

4. Applicant has rewritten claim 20 to include the limitations of claims 1 and 19, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 19 has been canceled. Accordingly, it is requested that the rejection of claims 19 and 20 under 35 U.S.C. § 103 (a) be withdrawn.

5. Applicant has rewritten claim 22 to include the limitations of claims 1 and 21, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 21 has been canceled. Claims 23-25 depend from claim 22. Accordingly, it is requested that the rejection of claims 21-25 under 35 U.S.C. § 103 (a) be withdrawn.

6. Applicant has rewritten claim 48 to include the limitations of claims 1 and 19, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 49 and 50 depend from claim 48. Accordingly, it is requested that the rejection of claims 48-50 under 35 U.S.C. § 103 (a) be withdrawn.

7. Applicant has rewritten claim 51 to include the limitations of claims 1 and 21, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Accordingly, it is requested that the rejection of claim 51 under 35 U.S.C. § 103 (a) be withdrawn.

8. Applicant has rewritten claim 52 to include the limitations of claims 1 and 21, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 53 depends from claim 52. Accordingly, it is requested that the rejection of claims 52 and 53 under 35 U.S.C. § 103 (a) be withdrawn.

9. Applicant has rewritten claim 54 to include the limitations of claims 1 and 21, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Accordingly, it is requested that the rejection of claim 54 under 35 U.S.C. § 103 (a) be withdrawn.

10. Applicant has rewritten claim 56 to include the limitations of claims 1, 21 and 55, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claim 55 has been canceled. Accordingly, it is requested that the rejection of claims 55 and 56 under 35 U.S.C. § 103 (a) be withdrawn.

11. Applicant has rewritten claim 57 to include the limitations of claims 1 and 21, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 58 and 59 depend from claim 57. Accordingly, it is requested that the rejection of claims 57-59 under 35 U.S.C. § 103 (a) be withdrawn.

12. Applicant has rewritten claim 60 to include the limitations of claim 1, which the examiner indicated would be allowable if rewritten in independent form to include all of the limitations of the base claim and any intervening claims. Claims 61 and 62 depend from claim 60. Accordingly, it is requested that the rejection of claims 60-62 under 35 U.S.C. § 103 (a) be withdrawn.

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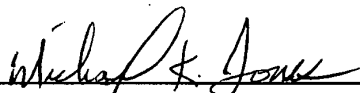
**ALLOWABLE SUBJECT MATTER**

In the Office Action, claims 3, 8-10, 16, 20, 22, 23, 48-54, and 56-62 are objected to as being dependent upon a rejected base claim, but the Office Action indicates that these claims would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims. As indicated above, claims 3 has been incorporated into claim 1 and claims 8, 16, 20, 22, 48, 51, 52, 54, 56, 57, and 60 have been rewritten to include all of the limitation of the base claim and any intervening claims.

**CONCLUSION**

For all the foregoing reasons, Applicants respectfully submit that claims 1, 2, 4-6, 8-14, 16-18, 20, 22-25, 48-54 and 56-62 patentably define over the prior art of record and are in condition for allowance. Reconsideration of the present Office Action and an early Notice of Allowance are respectfully requested. If the Examiner believes a telephone conference would be useful in moving the case forward, the Examiner is encouraged to contact the undersigned at (215) 568-3100.

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